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AUG 16 2007

OFFICE OF PETITIONS

In re Application of	:	
Noribumi Koitabashi et al.	:	
Application No. 09/349,473	:	DECISION ON PETITION
Filed: July 9, 1999	:	UNDER 37 C.F.R. §§ 1.181(A)
Attorney Docket No.: 1272.7910-	:	
DI	:	
Title: INK-JET APPARATUS	:	
EMPLOYING INK-JET HEAD HAVING A	:	
PLURALITY OF INK EJECTION	:	
HEATERS CORRESPONDING TO EACH	:	
INK EJECTION OPENING	:	

This is a decision on the "Petition to Withdraw Holding of Abandonment," filed on June 27, 2003, and resubmitted on September 20, 2006, which is properly treated as a petition pursuant to 37 C.F.R. § 1.181(a).

The Office regrets the period of delay in issuing this decision.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue fee and drawings in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 8, 2000, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting formal drawings or issue fees¹. Accordingly, the above-

¹ See MPEP §710.02(e).

identified application became abandoned on December 9, 2000. A Notice of Abandonment was mailed on March 20, 2001.

RELEVANT PORTIONS OF THE C.F.R. AND M.P.E.P.

37 C.F.R. § 1.63(d)(4) sets forth, *in toto*:

Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.

See also MPEP § 201.06(c) (VII)

37 C.F.R. § 1.33(a) sets forth, *in pertinent part*:

Correspondence address and daytime telephone number. When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing.

MPEP 711.03(c) states, *in pertinent part*:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action,

a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

The showing in the present petition is not sufficient to withdraw the holding of abandonment.

ANALYSIS

First, Petitioner has set forth that the present application is a divisional of 08/579,241, which was filed on December 28, 1995. Application number 08/579,241 was filed with a declaration which lists the correspondence address as "Fitzpatrick Cella Harper & Scinto, 277 Park Avenue, New York, NY, 10172."

Petitioner submitted a "Request for Customer Number Data Change," updating the address associated with this Customer Number to the 30 Rockefeller Plaza address, along with a spreadsheet with a plurality of application numbers, including application number 08/579,241 - it is noted that the request contains a date of May 29, 1998. It is not clear when this document was submitted to the Office (it does not appear to contain a certificate of mailing), however Petitioner has included a "Notice of Customer Number Record Change," which appears to have been mailed by the Office on June 22, 1998.

On July 9, 1999, the present application was filed, along with a copy of the declaration that is associated with the parent application - which lists the correspondence address as "Fitzpatrick Cella Harper & Scinto, 277 Park Avenue, New York, NY, 10172."

It is noted in passing that the inclusion of the parental declaration when filing a divisional application is permitted by 37 C.F.R. § 1.63(d)(1). However, as noted above, 37 C.F.R. § 1.63(d)(4) indicates that when the correspondence address was changed during the prosecution of the parent application, the change in address must be identified in the divisional application.

It does not appear that Petitioner identified the change of address in the divisional application. Consequently, during prosecution, all papers were mailed to the former address and it appears that Petitioner received the first Office action.

Petitioner failed to comply with Rule § 1.63(d)(4), and consequently, Office mailings were properly sent to the former address. It follows that Petitioner's request for the Office to withdraw the holding of abandonment must be **DISMISSED**.

Secondly, Petitioner has stated that the Office communication was not received, however, it does not appear that he has not set forth that he searched either the file jacket or the place where he normally would keep such communications and could not find it, and it does not appear that he has submitted a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

As such, Petitioner has not established non-receipt of the communication.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be

submitted by mail², hand-delivery³, or facsimile⁴. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁵.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b). Petitioner may download information about these petitions here:

http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁶. All other inquiries

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

4 (571) 273-8300- please note this is a central facsimile number.

5 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

concerning examination procedures or status of the application
should be directed to the Technology Center.



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